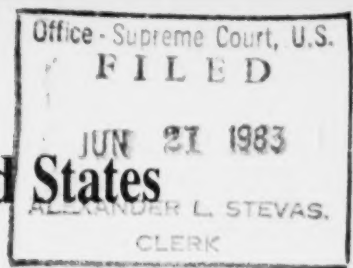


No. 82-1875  
IN THE  
**Supreme Court of the United States**



October Term, 1982

CARPET SEAMING TAPE LICENSING CORPORATION, a Texas  
corporation,

*Petitioner,*

vs.

BEST SEAM, INCORPORATED, a California corporation,  
*Respondent.*

CARPET SEAMING TAPE LICENSING CORPORATION, a Texas  
corporation,

*Petitioner,*

vs.

VECTRON INDUSTRIES, INC., a California corporation, and  
EUGENE J. TASSE, an individual,

*Respondents.*

**RESPONDENTS' BRIEF IN OPPOSITION TO  
PETITION FOR CERTIORARI.**

WILLIAM H. PAVITT, JR.,  
BEEHLER, PAVITT, SIEGEMUND,  
JAGGER & MARTELLA,  
1100 Equitable Plaza,  
3435 Wilshire Boulevard,  
Los Angeles, Calif. 90010-1978,  
(213) 385-7087,

*Attorneys for Respondents,  
Best Seam, Incorporated,  
Vectron Industries, Inc. and  
Eugene J. Tasse.*

### Questions Presented.

From the standpoint of respondents, the questions presented are:

1. Should this Court entertain a petition for *certiorari* which seeks to have this Court establish a new requirement for corroboration of evidence of obviousness to invalidate a patent under 35 U.S.C. § 103, where the contention for such requirement is unsupported by the authorities, and was never asserted in the courts below until petitioner sought a rehearing in the Court of Appeals?

2. Should the United States Supreme Court ignore its "two-court rule" and review a decision of a regional Court of Appeals affirming a district court's holding patents invalid for obviousness on factual grounds?

## TABLE OF CONTENTS

|   | Page |
|---|------|
| Questions Presented .....   | i    |
| Opinions Below .....  | 1    |
| Jurisdiction .....  | 2    |
| Statutory Provisions .....  | 2    |
| Statement of the Case .....   | 3    |
| Summary of Argument .....   | 5    |
| Argument .....  | 6    |
| I.  |      |
| Petitioner's Principal Point Was Not Raised, Litigated<br>or Passed Upon in the Lower Courts .....  | 6    |
| II.   |      |
| Petitioner Makes No Showing of Error to Avoid the<br>"Two-Court Rule" Which Makes Concurrent<br>Findings of Two Courts Below Final in This Court<br>..... | 7    |
| III.  |      |
| Petitioner Misreads the Opinion of the Court of<br>Appeals .....  | 10   |
| IV.   |      |
| There Is No Requirement of Corroboration for Prior<br>or Concurrent Work of Another to Be Considered<br>as Evidence of Obviousness .....                  | 13   |
| V.  |      |
| The District Court Did Not Act Improperly .....   | 15   |
| Conclusion .....  | 16   |

## TABLE OF AUTHORITIES

| Cases  | Page  |
|--|-------|
| Berenyi v. Immigration Service, 385 U.S. 630, 17 L.Ed. 2d 656 (1967) .....                                 | 7     |
| Chatz v. Medco Oil Co., 152 F.2d 153 (7th Cir. 1946) .....   | 7     |
| Clemens, 622 F.2d 1029 (CCPA, 1980) .....  | 14    |
| Del Mar Engineering Laboratories v. United States, 524 F.2d 1178 (Ct. Cl., 1975) .....                     | 14    |
| E. I. Du Pont de Nemours v. Berkley & Co., Inc., 620 F.2d 1246 (8th Cir. 1980) .....                       | 11    |
| Felburn v. New York Central Railroad Company, 350 F.2d 416 .....   | 13    |
| Graham v. John Deere Co., 383 U.S. 1, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966) .....                          | 2, 15 |
| Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 336 U.S. 271, 93 L.Ed. 672 (1949) .....                    | 7     |
| Lockheed Aircraft Corp. v. United States, 553 F.2d 69 (Ct. Cl., 1977) .....                                | 14    |
| McCullough v. Kammerer Corp., 323 U.S. 327, 89 L.Ed. 273 .....   | 6     |
| Miree v. De Kalb County, 433 U.S. 25, 53 L.Ed. 2d 557 .....  | 6     |
| Partenweederei, etc. Weigel, 313 F.2d 423 (9th Cir. 1962), cert. den., 373 U.S. 904, 10 L.Ed. 2d 199 ..... | 6     |
| Rudolph v. United States, 370 U.S. 269, 8 L.Ed. 2d 484, reh. den. 371 U.S. 854, 9 L.Ed. 2d 93 (1962) ..... | 7     |
| Servo Corp. of America v. G. E. Co., 337 F.2d 716 (4th Cir. 1964) .....                                    | 13    |
| Simmons Precision Products v. United States, 153 U.S.P.Q. 465 (Ct. Cl., 1977) .....                        | 14    |

|  | Page                      |
|--|---------------------------|
| Stephens v. Arrow Lumber Co., 354 F.2d 732 (9th Cir. 1966) .....           | 7                         |
| Rule   |                           |
| Federal Rules of Civil Procedure, Rule 52(a) .....                         | 10                        |
| Statutes   |                           |
| United States Code, Title 28, Sec. 1295(a) .....                           | 8                         |
| United States Code, Title 35, Sec. 102 .....                               | 14                        |
| Code of Civil Procedure, Title 35, Sec. 102(a) .....                       |                           |
| .....  | 11, 12, 13, 14, 15        |
| United States Code, Title 35, Sec. 102(f) .....                            |                           |
| .....  | 10, 12, 13, 15            |
| United States Code, Title 35, Sec. 102(g) .....                            |                           |
| .....  | 11, 12, 13, 15            |
| United States Code, Title 35, Sec. 103 .....                               |                           |
| .....  | i, 2, 5, 6, 8, 13, 14, 15 |
| Textbook   |                           |
| Stern & Gressman, Supreme Court Practice (5th ed., BNA), pp. 290-291 ..... | 7                         |

No. 82-1875  
IN THE  
**Supreme Court of the United States**

---

October Term, 1982

---

CARPET SEAMING TAPE LICENSING CORPORATION, a Texas  
corporation,

*Petitioner,*

vs.

BEST SEAM, INCORPORATED, a California corporation,  
*Respondent.*

---

CARPET SEAMING TAPE LICENSING CORPORATION, a Texas  
corporation,

*Petitioner,*

vs.

VECTRON INDUSTRIES, INC., a California corporation, and  
EUGENE J. TASSE, an individual,

*Respondents.*

---

**RESPONDENTS' BRIEF IN OPPOSITION TO  
PETITION FOR CERTIORARI.**

---

**Opinions Below.**

The present petition is from the second decision of the Court of Appeals for the Ninth Circuit in the case, the first decision having reversed the trial court to send the case back for further trial, since the trial court had initially dismissed plaintiff's action on defendants' motion at the close of plain-

tiff's evidence. In so dismissing plaintiff's action, the District Court had made findings of fact and conclusions of law reported at 197 U.S.P.Q. 230. After the case was further tried, the District Court again found the patents-in-suit invalid on various grounds, including derivation and obviousness. The Court readopted its original findings of fact, filed September 8, 1977 *in toto*, and then proceeded to make extensive additional findings of fact and new conclusions of law, as set forth in pages A28 through A62 of the appendix to petitioner's petition/brief.

Upon petitioner's second appeal to the Court of Appeal for the Ninth Circuit, that Court affirmed the ruling of the trial court that each of the patents-in-suit is invalid for obviousness under 35 U.S.C. § 103, and the standards enunciated under *Graham v. John Deere Co.*, 383 U.S. 1 (1966) (Pet. appendix A8). However, the Court of Appeal reversed the trial court's holding that the patents-in-suit were also invalid for derivation, stating that the trial court's finding that there was clear and convincing evidence that the central concept underlying the Burgess inventions was derived from Walters' (prior) work cannot stand (Pet. appendix A15). The Court of Appeals also reversed the trial court on certain other issues which are not involved in the petition for *certiorari*.

### **Jurisdiction.**

Respondents concur in the jurisdictional statement set forth on page 2 of petitioner's brief.

### **Statutory Provisions.**

In addition to the statutory provisions quoted on pages 2 and 3 of the petition, respondents would add the following:

United States Code, Title 28:

“Section 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit

“(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction —

“(1) of an appeal from a final decision of a district court of the United States, \* \* \* if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title, [relating to patents] \* \* \*.”

### **Statement of the Case.**

This case involves a controversy over the origin of the use effective hot melt adhesives in carpet seaming. Contrary to what petitioner asserts to have been the principal problem in the use of hot melt adhesives, the real problem was the lack of a suitable adhesive.<sup>1</sup> The breakthrough occurred in or about November of 1965 in the form of a hot melt adhesive called “THERMO-GRIP” sold by United Shoe Machinery Co. as sticks and dispensable by means of an electrically heated gun into which the sticks were inserted. This “THERMO-GRIP” product and gun came to the attention of one Mr. Walters, an officer of the Mill Store, a carpet retail establishment in La Grange, Georgia, through his reading of the December 1965 issue of Popular Science Magazine (TR 8/6/80 pp. 48-49). Mr. Walters procured a “THERMO-GRIP” gun and adhesive and, for some time prior to January 31, 1966, experimented with the gun initially and, later, with the adhesive separately to make thermoplastic tapes and use them in both back seaming *and face seaming* of carpeting (TR 8/6/80 pp. 50-51, 53). On January 31, 1966, Walters actually had the “THERMO-GRIP” adhesive used by two of his store employees in making a carpet installation with open weave tape in back

---

<sup>1</sup>Thus, Burgess testified at the first trial that when he tried to use tape with hot melt which was available some six months before February 1966, to seam carpeting, “it fell apart from its own weight.” (TR 7/13/77 pp. 21-22). Also, Walters testified that he “was continually looking for a new adhesive to use on tape” (TR 9/2/80 p. 104).



seaming the carpeting in the golf shop of the Georgia Warm Springs Foundation (TR 8/6/80 pp. 53-56).

On or about February 2, 1966, one Robert Powell, a salesman for a supplier to Mr. Walters' establishment, made one of his regular calls upon the latter and, in the course of his call observed a sample of hot melt adhesively seamed carpet on Mr. Walters' desk (DX DV pp. 8-9). In response to Powell's inquiry about this sample, Mr. Walters explained to, and showed Mr. Powell what Walters had been doing with the "THERMO-GRIP" adhesive, including both back seaming and face seaming with strips of tape which he had impregnated with the "THERMO-GRIP" adhesive and which, after cooling of the adhesive, he rolled up and later reactivated by reheating the adhesive (TR 8/6/80 pp. 59-62; TR 9/2/80 pp. 61-66; DX DV pp. 10, 13-27). The trial court heard Mr. Walters' testimony concerning what he had done, and what he had shown to, and discussed with Mr. Powell, on or about February 2, 1966 (TR 8/6/80 pp. 45-66; TR 9/2/80 pp. 54-106).

It was on the following day that Mr. Powell proceeded to Macon, Georgia where he called upon Mr. Burgess (DX DV pp. 27-29). There is no doubt that Mr. Powell told Mr. Burgess a great deal about what he learned on the previous day from Mr. Walters (TR 8/6/80 pp. 15-17, 18-26). A principal issue, however, was whether Mr. Powell told Mr. Burgess about Mr. Walters' face seaming work with pre-made tapes. The trial court found that Mr. Burgess had derived his so-called inventions from Walters through Powell and, in not disclosing his knowledge of Walters' work to the U.S. Patent Office, was guilty of fraud (Appendix to Petition p. A61). The Court of Appeals held that this finding was not sufficiently supported by testimony to the effect that Powell had disclosed to Burgess Walters' having face seamed with a precoated tape (*id.*, p. A15). The Court of

Appeals did, however, affirm the District Court's holding that the inventions of the patent-in-suit were invalid for obviousness under 35 U.S.C. 103 (*id.*, pp. A12-13).

Because Mr. Walters felt that what he had done was too obvious to secure patent protection, he did not try to apply for a patent (TR 9/2/80 p. 102). Further, he felt that, without patent protection, "It wasn't worth spending a lot of money and proceeding in development and buying machinery." (TR 9/2/80 p. 102). Mr. Burgess, however, did proceed to file patent applications on hot melt carpet seamings.

### **Summary of Argument.**

- I. Petitioner's principal point was not raised, litigated or passed upon in the lower courts.
- II. Petitioner makes no showing of error to avoid the "two-court rule" which makes concurrent findings of two courts below final in this Court.
- III. Petitioner misreads the opinion of the Court of Appeals.
- IV. There is no requirement of corroboration for prior or concurrent work of another to be considered as evidence of obviousness.
- V. The District Court did not act improperly.

## ARGUMENT.

### I.

#### **Petitioner's Principal Point Was Not Raised, Litigated or Passed Upon in the Lower Courts.**

Petitioner's contention that for a trial court to consider the work of an earlier inventor as "prior art" in determining obviousness under 35 U.S.C. § 103, such work must be "corroborated," was not raised before the District Court, and was only first raised as an afterthought in its petition for rehearing in the Court of Appeals.

This Court has previously indicated clearly that a point thus belatedly raised does not merit this Court's granting of a writ of *certiorari*.

See: *McCullough v. Kammerer Corp.*, 323 U.S. 327, 89 L.Ed. 273

*Miree v. De Kalb County*, 433 U.S. 25, 53 L.Ed. 2d 557

This is but a corollary of established appellate practice. As the Ninth Circuit stated in *Partenweederei, etc. v. Weigel*, 313 F.2d 423, 425 (9th Cir. 1962) c.d. 373 U.S. 904, 10 L.Ed. 2d 199:

"It is sound policy to require that all claims be presented to the trial court, and not raised for the first time on appeal, nor, a fortiori, as herein, in a petition for rehearing on appeal. This requirement sets the scope of the lawsuit, thereby preventing piecemeal litigation and consequent waste of the time of both trial and appellate courts. It assures that the opposing party will know the claims he must meet. It gives the appellate court the benefit of the district court's wisdom, and it prevents a litigant from asserting before this Court a claim which he deliberately chose, for reasons of strategy, not to assert below. We find here no persuasive reason for making an exception."

See also: *Stephens v. Arrow Lumber Co.*, 354 F.2d 732, 734 (9th Cir. 1966)

*Chatz v. Medco Oil Co.*, 152 F.2d 153, 154 (7th Cir. 1946)

## II.

### **Petitioner Makes No Showing of Error to Avoid the “Two-Court Rule” Which Makes Concurrent Findings of Two Courts Below Final in This Court.**

This rule has been stated and alluded to in such cases as:

*Rudolph v. United States*, 370 U.S. 269, 8 L.Ed. 2d 484, reh. den. 371 U.S. 854, 9 L.Ed. 2d 93 (1962)

*Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 93 L.Ed. 672 (1949)

*Berenyi v. Immigration Service*, 385 U.S. 630, 17 L.Ed. 2d 656 (1967)

See also: Stern & Gressman, SUPREME COURT PRACTICE (5th ed., BNA) 290-291

In the words of this Court in *Berenyi*:

“The policy underlying the ‘two-court’ rules is obvious. This Court possesses no empirical expertise to set against the careful and reasonable conclusions of lower courts on purely factual issues. When, as here, resolution of the disputed factual issues turns largely on an assessment of the relative credibility of witnesses whose testimonial demeanor was observed only by the trial court, the rule has particular force.” (385 U.S. 630 at 635-636).

This “two-court” rule is particularly apposite to the present patent case where disputed factual issues were resolved by the District Court which heard the most important witnesses, and the District Court’s factual findings and conclusion of obviousness of the patents were affirmed by the

Court of Appeals for the Ninth Circuit.<sup>2</sup>

In essence, petitioner's real contention advanced in its petition is that both the District Court, and the unanimous Court of Appeals for the Ninth Circuit, committed reversible error in making those factual findings (and sustaining such findings) on the basis of which the alleged inventions of Mr. Burgess in the carpet seaming field were held by those Courts to be "obvious," and the patents, therefore, invalid under 35 U.S.C. § 103.

On this issue, the conflict in evidence was essentially between Mr. Burgess, the alleged "inventor," and a paid expert witness called by petitioner, on the one hand, and Mr. Walters and Mr. Powell, presented by the defendants, on the other hand. Mr. Walters testified in person at the second trial; Mr. Powell testified by way of deposition. The trial court had full opportunity to observe the demeanor of Mr. Burgess and petitioner's paid expert witness, on the one hand, and that of Mr. Walters (who testified for two days), on the other hand, and to determine their respective credibility and the appropriate weight to be given to their testimony. Among other facts, Walters' testimony particularly established the following:

1. As soon as the new "THERMO-GRIP" adhesive came to the attention of Mr. Walters in November, 1965, and he was shortly thereafter able to procure the same, it occurred to Walters to try it for seaming carpeting and by January of 1966 he made up tapes *precoated* with hot melt adhesive and had used them for both back seaming and *face seaming* (TR 8/6/80 pp. 49-53 and TR 9/2/80 pp. 56-62).

---

<sup>2</sup>It should be noted in passing that, since October 1, 1982, all appeals from district court judgments in cases where jurisdiction has been or is predicated upon United States patents, are directed exclusively to the new United States Court of Appeals for the Federal Circuit [28 U.S.C. 1295(a)].

2. Walters, a man of ordinary skill in this art, testified that to him it was obvious to use tapes precoated with hot melt adhesive for both back seaming and face seaming (TR 9/2/80 pp. 66-67; TR 8/6/80 pp. 61-62). Petitioner's statement to the effect that the testimony of its experts was "uncontroverted" on the issue of obviousness (Pet. p. 22) is thus in error.

3. Because Walters felt the process was so obvious, he determined it was not worth seeking to obtain the patent protection on the same (TR 9/2/80 p. 102).

4. Powell, who was also experienced in carpet installing, testified that he did not think Burgess had a right to seek a patent because "at that time, with the other products that had been on the market, I thought it was too closely related to the product that Bigelow-Sanford had out." (DX DV pp. 42-43). This, in effect, was this layman's simple way of stating that the product was obvious to him.

With respect to Burgess' own testimony and the admitted facts in the pretrial order, the following was established:

Powell learned of Walters' work on February 2, 1966 when he visited the Mill Store of Walters in La Grange, Georgia.

On the following day, Powell visited Burgess' place in Macon, Georgia and at least told Burgess about the "THERMO-GRIP" adhesive and the dispensing gun about which he had learned from someone at the Mill Store.

Burgess admitted that a few weeks later he initiated a call to the Calloway Mills (of which the Walters' Mill Store was the outlet store), but was not able to reach anyone who knew anything about "a thermoplastic tape," (i.e., Walters) (TR 8/6/80 pp. 17-18).

Within six weeks, Burgess had signed his initial patent application in New York City en route to an appointment



in Boston to meet with United Shoe Machinery Co. (the manufacturer of THERMO-GRIP) in an unsuccessful effort to interest the latter in "his invention."

Respondent submits that if there was not derivation of the invention by Burgess from Walters through Powell, as the Court of Appeals held,<sup>3</sup> Burgess' immediate use of the new "THERMO-GRIP" adhesive to seam carpeting after Powell's visit on February 3, 1966, is wholly consistent with the affirmed finding of obviousness (based upon Walters' testimony and other evidence).

The trial court finding cannot be set aside unless clearly erroneous [Federal Rule 52(a)]. The Court of Appeals held it was not.

Petitioner disagrees with the two courts below on their weighing of this evidence, and, therefore, now seeks to have this Court reweight it. No adequate reason, however, is presented in the petition for this Court to depart from its "two-court" rule, or to subvert the policies served by that rule.

### III.

#### **Petitioner Misreads the Opinion of the Court of Appeals.**

In its argument, petitioner asserts, in effect, that what Walters had done in face seaming, if not disclosed to Burgess to support *a defense of derivation* under 35 U.S.C. § 102(f) (as the Court of Appeals held), would not be avail-

---

<sup>3</sup>The trial court specifically found Burgess had derived his so-called invention from Walters through Powell, and was guilty of fraud in failing to disclose this to the Patent Office. The Court of Appeals reversed the trial court on this finding (for lack, it stated, of specific evidence that Powell had passed on to Burgess a disclosure of certain elements of Walters' work). While respondents still believe that derivation, in fact, did take place, and that the trial court's finding was fully supported by the record, that issue has become moot, since the Court of Appeals affirmed the trial court judgment in favor of respondents on the issue of obviousness.

able against Burgess as prior art under 35 U.S.C. § 102(g) and 103 (Pet. p. 16). Respondents submit that in making this assertion petitioner is simply seeking to generate confusion as to the real issue in an effort to make it appear that the present case involves some point of patent law.

In order to clarify the situation, respondents offer the following:

In the first place, even though the Court of Appeals held that Walters' work in face seaming was partially uncorroborated, it did not hold that Walters was not the prior inventor under 102(a) or (g), but only that the trial court's finding that "there was clear and convincing evidence that the central concept underlying the Burgess invention was *derived* from Walters' work, as disclosed to Burgess by Powell cannot stand" (emphasis supplied) (Pet. Appendix A15).

In the second place, corroboration of the work of a prior inventor is not always required, as where the district court is persuaded by hearing the testimony of a witness and considering exhibits introduced in conjunction with such testimony.

See: *E. I. Du Pont de Nemours v. Berkley & Co., Inc.*, 620 F.2d 1246, 1261 (8th Cir. 1980)

In addition, petitioner's statements, to the effect that Walters' work represented only secret abandoned experiments not communicated to the public, ignore the evidence of record.

Walters' work was not an abandoned experiment. He had reduced the alleged face seaming to practice, and used it commercially "on a number of seams in the store," to make up "runners," and "on small jobs in the store" (TR 8/6/80 p. 53). Walters also used his technique to make at least one public installation by back seaming (id). Moreover, he



did not hide what he had done, having a seamed carpet sample on his desk for anyone to see, as Powell did, and, when asked about it, Walters immediately took time to explain what he had been doing to Powell (TR 8/6/80 p. 60). Indeed, it was *by* such willing disclosure by Walters to Powell that Burgess was introduced to the subject. Thus, Walters cannot be charged with concealment of what he had been doing in hot melt carpet seaming work — and certainly not by Burgess.

In its petition, petitioner has omitted any reference to the key fact that the first time an adhesive effective for carpet seaming became available was when United Shoe Machinery Co. put its “THERMO-GRIP” adhesive and “THERMO-GRIP” gun on the market. Yet, this was the very adhesive referred to in Burgess’ first filed patent application (DX C).

The availability of this “THERMO-GRIP” adhesive enabled Walters to engage in his work which included making precoated tapes and actually seaming carpeting in the Mill Store in January of 1966 (TR 8/6/80 pp. 51, 53), culminating in the commercial installation of hot melt seamed carpeting in the golf shop of the Georgia Warm Springs Foundation on January 31, 1966 (TR 8/6/80 pp. 53-55). That Walters both back seamed and face seamed with precoated tape was corroborated by Powell’s deposition testimony (DX DV pages 16-31). What the Court of Appeals felt was not sufficiently corroborated to invalidate the patents for derivative under 35 U.S.C. § 102(a), (f) and (g), apparently, was that Powell on February 3, 1966 had explained *all* of what Walters had done, *including face* seaming to Burgess. It did, however, affirm the district court’s invalidation of the patents for obviousness (Pet. A 12-13).

#### IV.

### **There Is No Requirement of Corroboration for Prior or Concurrent Work of Another to Be Considered as Evidence of Obviousness.**

Petitioner seeks to import into the test for obviousness under 35 U.S.C. § 103, certain requirements for the invalidation of patents under Section 102 (a), (f) and (g), as, for example, corroboration, and that the prior invention not have been abandoned or withheld from the public. This, however, has uniformly *not* been the law.

Thus, in *Servo Corp. of America v. G. E. Co.*, 337 F.2d 716 (4th Cir. 1964), the Court stated at p. 720:

“While it is true that both the master and the district court doubted that Fattor’s proposals received the degree of publicity necessary to constitute prior art and while there is no evidence that Servo ever learned of them, *nevertheless they constitute evidence of the obviousness* of this position as one which would logically be considered for a permanent installation by anyone skilled in the art. *United States Pipe and Foundry Co. v. Woodward Iron Co.*, 327 F.2d 242 (4 Cir.), rehearing denied, 329 F.2d 578 (4 Cir. 1964).” (emphasis supplied)

In *Felburn v. New York Central Railroad Company*, 350 F.2d 416, the Court, after acknowledging a question as to whether a brochure qualifies as a publication under Section 102, stated at p. 425:

“Instead, we find in Behrens’ testimony and the brochure credible evidence of an *independent development* of the subject matter of the ’636 patent by a third party, which we here regard as *persuasive* that the claimed invention *would have been obvious* to one of ordinary skill in this art. See *Lempco Prods., Inc. v. Simmons*, 140 F.2d 58 (6th Cir. 1944).” (emphasis supplied)

Similarly, in *Del Mar Engineering Laboratories v. United States*, 524 F.2d 1178 (Ct. Cl., 1975), the court held that although a classified document would not qualify as an invalidating publication under 35 U.S.C. 102(a), it supplied “*probative evidence of what the general level of skill in the art was at the time the instant invention was made.*” (524 F.2d 1182-3). (emphasis supplied)

Among other cases which have held that classified reports not qualifying as “prior art” under Sections 102 and 103, may nevertheless be considered as evidence of obviousness under Section 103, are:

*Lockheed Aircraft Corp. v. United States*, 553 F.2d 69, 78 (Ct. Cl., 1977);

*Simmons Precision Products v. United States*, 153 U.S.P.Q. 465, 468 (Ct. Cl., 1977).

It is thus clear that in determining the level of skill in the art and “obviousness” under 35 U.S.C. § 103, a district court may consider facts relating to what others have done prior to the alleged inventors, even though such facts would not be sufficient to qualify such prior acts or reports as “prior art” under one of the subsections of 35 U.S.C. § 102.

The case of *In re Clemens*, 622 F.2d 1029 (CCPA, 1980) cited and quoted from by petitioner is not to the contrary. That case involved prosecution of a patent application in which the Examiner relied upon a patent issued on an application assigned to a common assignee. The Court ruled that the applicant Clemens, on the record, could not be charged with knowledge, *as prior art*, of the invention of the prior patentee which was also not known to the public. This is quite different from the case at Bar where the Court of Appeals treated Walters’ prior work not as “prior art,” but rather as *evidence* of the level of skill in the art, in accordance with the numerous authorities cited and dis-

cussed hereinabove.

The prior art in the present case comprised the patents which were before the trial court, starting with *Higgins* in 1933 which taught face seaming, and the other patents which disclosed such things as impregnated tapes and paper backed tapes. The prior art also comprised the new THERMO-GRIP adhesive introduced by United Shoe Machinery Co. in November 1965.

With this prior art before the Courts below, the focus then shifted to ascertaining the level of ordinary skill in the art and determining whether what Burgess claimed he invented, would have been obvious to such a person of ordinary skill.

In so following the formula prescribed by this Court in *Graham v. John Deere Co.*, 383 U.S. 1, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966), the district Court concluded that the alleged inventions of the patents-in-suit would have been obvious under 35 U.S.C. 103. In reaching this conclusion, the District Court was entitled to accept, as the Court of Appeals held, as evidence of the level of ordinary skill in the art, what Walters in fact had done, and his testimony as to what was obvious to him, in the way of hot melt carpet seaming as soon as the "THERMO-GRIP" adhesive became available — irrespective of whether his testimony was corroborated to the extent apparently required by the Court of Appeals to show proof of derivation by Burgess to invalidate the patents under 35 U.S.C. § 102 (a), (f) and (g).

## V.

### **The District Court Did Not Act Improperly.**

Petitioner criticizes the District Court for having "a lifetime judicial record of having decided twelve patent cases" in which he found invalid all twenty patents involved in those cases (Pet. p. 13). Petitioner does not, however, pro-

vide any statistics as to the number of cases which the District Court was affirmed by the Court of Appeals for the Ninth Circuit.

A careful review of all of Judge Real's cases will reveal that in *no case* where his invalidation of a patent or patents was appealed, has the Court of Appeals reversed and held a patent valid (as distinguished from reversing a summary judgment because of a possible issue of fact). This indeed appears to be a most remarkable record for the District Court's more than seventeen years on the District Court bench.

Perhaps the answer to petitioner's observation concerning Judge Real's record is that in most cases where patents are litigated, it is because the patents have apparent deficiencies or failings, and such deficiencies or failings are recognized and adjudicated by such experienced and intelligent jurists as Judge Real.

Petitioner also criticizes the District Court for having adopted the findings submitted on behalf of respondents. However, it should be noted that both parties stipulated, and the District Court therefore orderd, that the parties would file in advance of the second trial, proposed findings of fact and conclusions of law and did so on July 18, 1980. (See Docket Sheet R. 388). Respondents submit that it ill becomes petitioner — having invited this very procedure by the trial court — to complain after losing at trial that the District Court adopted respondents', instead of petitioner's proposed findings of fact and conclusions of law.

### **Conclusion.**

Both courts below held that there was sufficient evidence to sustain the finding made by the trial court that the alleged "inventions" here in suit were obvious to persons of ordinary skill in the art and that the patents-in-suit were there-

fore invalid. Petitioner's attempt to subvert this result by advancing arguments not made in the two courts below is untimely, unfair and entirely without merit.

The petition for *certiorari* should be denied.

Respectfully submitted,

BEEHLER, PAVITT, SIEGEMUND,

JAGGER & MARTELLA,

WILLIAM H. PAVITT, JR.,

*Attorney for Respondents.*